

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

F. William Daugherty, et al.

Application No: 09/963,246

Filed: September 26, 2001

For: SYSTEM AND METHOD FOR
FACILITATING INFORMATION
REQUESTS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NON-COMPLIANT APPEAL BRIEF

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief dated August 30, 2006, Applicants submit herewith an Amended Appeal Brief presenting arguments under separate headings.

Applicants respectfully submit that the Appeal Brief as filed does contain a concise explanation of the subject matter of the claims involved in the appeal.

Applicants note, in particular, that 37 CFR § 41.37 provides that:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in

the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

37 CFR § 41.37 only requires that each limitation of each independent claim be mapped to the specification by page and line number and to the drawings only if the claims involve a means plus function or step plus function limitations as permitted by 35 U.S.C. 112, sixth paragraph. The presently pending claims do not include such limitations. Accordingly, a precise mapping for each limitation of each independent claim is not required in the present application.

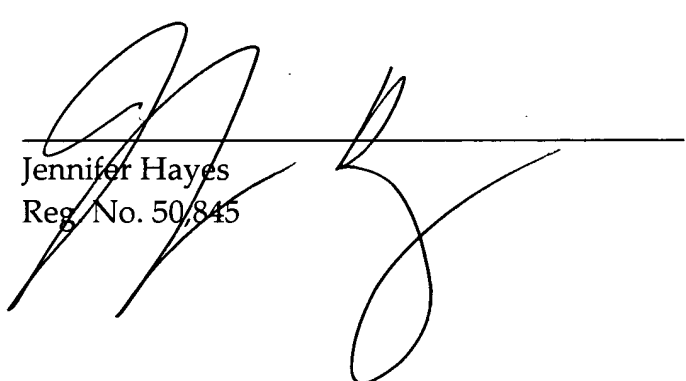
Accordingly, Applicants respectfully submit the Amended Appeal Brief complies with the provisions of 37 CFR § 41.37.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: October 4, 2006

Jennifer Hayes
Reg. No. 50,845



12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300

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I. REAL PARTY IN INTEREST

The real party in interest is IAC Search & Media, Inc., a corporation of Delaware having a principle place of business at 555 12th Street, Suite 500, Oakland, CA 94607.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

Claims 1-27 are currently pending and stand rejected by the Examiner under the Final Rejection mailed on March 9, 2006.

IV. STATUS OF AMENDMENTS

No amendment after final was filed. A copy of all claims on appeal is attached in Appendix A hereto.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Embodiments of the claimed invention include systems, methods and articles of manufacture that provide a user several choices as to additional sources of information and provide a personalize response based on a user's selection. (See page 1, lines 27-31 of the present specification.)

An advertisement is served having a plurality of associated selectable options. Each of the selectable options is associated with a different information delivery process, such as, for example, email, mail and/or a link. Other exemplary options for providing the addition information to the user include

special deal, but now, deliver now, download now, stream/see/listen now, make a reservation and the like. A user selects one of these selectable options, and additional information is received from the user depending on which of the selectable options is selected by the user. The additional information requested is then sent using the process selected by the user using the information provided by the user. (See page 4, line22 – page 6, line 13 and Figures 2 and 3 of the present specification.)

As shown in the embodiment illustrated in Figure 2 and discussed above, exemplary selectable options in an advertisement include “show more information,” “email more information” and “send more information.” The user selects one of these (or other) options, and the input required from the user depends on which option is selected. For example, if the user selects “email more information,” the server must have an e-mail address to which the information can be emailed. Thus, the input received from the user is an email address. In contrast, if, for example, the user selects “send more information,” the server typically needs a home address to which the information can be sent. Thus, the input received from the user is a home address, which differs from an email address. It is clear that the input needed from the user differs depending on the option selected in the advertisement. (See page 4, line22 – page 6, line 13 and Figures 2 and 3 of the present specification.)

The user selection generates information that may be of interest to advertisers. For example, it is of interest to advertisers to know which displays produced requests for more information, email, brochures, and which categories

of users made which requests, etc. A tracking system can monitor the activity and provide the information to a third party or another web site. (See page 6, lines 25-30 of the present specification.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be revealed on appeal are:

- ♦ Whether claims 1-20 and 26 are unpatentable under 35 U.S.C. § 103 as being obvious over Davis, et al. (U.S. Patent No. 6,138,155, hereinafter "Davis") in view of Marsh, et al. (U.S. Patent No. 5,848,397, hereinafter "Marsh").
- ♦ Whether claims 21-25 and 27 are unpatentable under 35 U.S.C. § 103 as being obvious over Davis in view of Marsh.

VII. ARGUMENT

A. CLAIMS 1-20 AND 26

1. REJECTION OF THE PRESENT INVENTION IS IMPROPER BECAUSE NO PRIOR ART REFERENCE TEACHES OR SUGGESTS PROVIDING INFORMATION BASED ON A SELECTABLE DELIVERY OPTION IN AN ADVERTISEMENT AND USER INPUT THAT DIFFERS WITH THE SELECTED DELIVERY OPTION.

Independent claim 1 recites:

1. A method for providing information to a user accessing a World Wide Web site, comprising:
 - (i) serving an advertisement associated with a first World Wide Web site, *wherein said advertisement has a plurality of associated selectable options that are displayed when said advertisement is displayed, further wherein each of said plurality of selectable options has an associated information delivery process, wherein the associated information*

delivery process differs for each of said plurality of selectable options;

(ii) receiving an indication of a selection of said one plurality of selectable options associated with said advertisement;

(iii) receiving an input from the user identifying where the information is to be sent, *the input differing depending on the selection made in (ii)*; and

(iv) providing information associated with said advertisement via said information delivery process associated with the selected one of said plurality of selectable options.

Similar limitations are included in independent claims 17 and 26.

Independent claims 1, 17 and 26 are rejected as being unpatentable over Davis in view of Marsh.

Davis is directed to a system and method for monitoring and profiling users based on their interaction with a system. The system creates a complex historical user profile to target an ad banner based upon the diverse interests of respective users. Davis explains that when a user is exposed to an ad banner having information targeted to their particular interests, the user is more likely to interact with that ad banner for a longer period of time and on a more frequent basis.

Davis further explains that an ad banner may include specific information permitting the user to interact in different ways with the banner. Davis explains that an ad banner may have pull-down menu options, clickable buttons or "hot-spots, keyboard input, or any number of input mechanisms, whose selection or action upon in a designated manner causes corresponding events to take place in the ad banner such as the generation or synthesis of sounds, the display of images,

video, or graphic animations, or the presentation of different types of information to the user, perhaps with additional choices. Such information may, for example, include links to interactive games, links to entertainment information sports-related information and/or trivia, and the like, or information concerning particular goods and services, or means by which to order or purchase specific goods and services.

Davis does not disclose that any of these input mechanisms are associated with an information delivery process that differs for each selectable option.

Similarly, Davis does not disclose that input from the user is received identifying where information is to be sent.

Moreover, Davis does not disclose that the input entered depends on which selectable option is selected by the user.

The Examiner submits Marsh discloses an ad banner that allows users to request for information to the email of the banner-associated vendor and submits that it would be obvious to have provided several convenient options for delivery of information through well known communication channels, each of which would require different types of information in order for fulfillment based on this teaching. Applicants respectfully disagree.

Marsh is directed to a system and method for scheduling advertisement displays. One such advertisement is a banner advertisement, which may be interactive. The user may be provided with additional information concerning the subject matter of the banner by clicking on a specified portion of the banner advertisement. Marsh discloses that: "Likewise, the user may access an e-mail

message template including the e-mail address of a vendor associated with the banner advertisement being displayed” or cause an e-mail message to be automatically completed.

However, the user in Marsh has no control over how the information is delivered to the user. The user does not have more than one selectable option having differing delivery processes.

The only method described in Marsh for requesting additional information is e-mail. And, the input from the user does not depend on the selection made for requesting additional information because only one selection can be made in Marsh: e-mail.

Moreover, the system in Marsh is off-line. Marsh teaches that it presents advertisements only when the system is off-line or when a connection is being made to the system. See Col. 6, line 66 – col. 7, line 6.

The Examiner submits that Marsh’s teaching for requesting information by email would motivate one to offer other well known delivery options, such as by telephone, postal mail, fax, etc., in order to offer a variety of convenient information, and that both David and Marsh teach plural interactive elements on a banner. Applicants respectfully disagree.

The interactive elements in Davis do not have an information delivery process associated with the interactive elements that requires different input from the user. In particular, receiving sound, videos, etc. do not require any input from the user.

The only delivery option contemplated by Marsh is email. Neither Davis nor Marsh disclose sending information to a user by telephone, postal mail, fax, etc. Thus, Marsh and Davis fail to disclose differing information delivery processes that would require different user input.

Thus, neither Davis, Marsh nor any other reference cited by the Examiner teaches or suggests providing information based on a selectable delivery option in an advertisement and user input that differs with the selected delivery option.

2. *REJECTION OF THE PRESENT INVENTION IS
IMPROPER BECAUSE THERE IS NO MOTIVATION TO
COMBINE THE CITED ART TO ARRIVE AT THE
CLAIMED INVENTION*

The Examiner submits that “The obviousness rejection set forth would provide for plural interaction options on the banner ad, each of which corresponds to ‘learn more via telephone’ and ‘learn more via postal mail’ in addition to ‘learn more via email’ option. Clearly each of these requires different types of information in order for fulfillment.”

Applicants respectfully submit the Examiner is using impermissible hindsight, based on Applicant’s own disclosure, to combine Davis and Marsh to arrive at the presently claimed invention.

As discussed above, Marsh is directed to a system and method for scheduling displays of advertisements. The banner ads in Marsh are presented to users, and the user’s interaction with the ad banners can be tracked to gain additional information about the banner ad. The information acquired by the system in Marsh is used to schedule and target future banner ads to the user.

Davis provides a method and apparatus for tracking client interaction with a network so that targeted information can be sent to particular users based on their interests and preferences. An ad banner can then be targeted to each user based on the tracking information. By providing the user with several options the system can also be used to obtain additional user preferences.

Thus, both Davis and Marsh relate to tracking user information. In Marsh, the information is tracked to gain additional information about user preferences so that subsequent advertisements can be better targeted. Thus, in Davis and Marsh, the system is guessing the user's preferences based on their previous interactions with the system.

In contrast, the present invention specifically provides the user several choices as to additional sources of information. The user can choose to obtain the information at once, by email or by conventional delivery services. Whatever the choice, the invention is able to provide personalized responses to the user based on the user's choice in the advertisement. Thus, the website operator is able to provide the user the information that the user wants because the user selects the type of information they want to receive and how they would like to receive it by selecting an option presented in the advertisement. This can be accomplished without tracking previous interaction by the user with the system or knowing user preferences.

Thus, there is no motivation to combine the cited art to arrive at the claimed invention. In particular, there is no motivation to combine the cited art to arrive at providing information based on a selectable delivery option in an advertisement

and user input that differs with the selected delivery option or providing an indication of a selection of a selectable delivery option in an advertisement and user input that differs with the selected delivery option.

B. CLAIMS 21-25 AND 27

1. REJECTION OF THE PRESENT INVENTION IS IMPROPER BECAUSE NO PRIOR ART REFERENCE TEACHES OR SUGGESTS PROVIDING AN INDICATION OF A SELECTION OF A SELECTABLE DELIVERY OPTION IN AN ADVERTISEMENT AND USER INPUT THAT DIFFERS WITH THE SELECTED DELIVERY OPTION.

Independent claim 21 recites:

21. A method for facilitating delivery of third party information to a visitor of a World Wide Web site, comprising:
 - (i) displaying a displayable item on a World Wide Web site, *wherein said displayable item is associated with a third party and has a plurality of associated selectable options, further wherein each of said plurality of selectable options has an associated information delivery process, wherein the associated information delivery process differs for each of said plurality of selectable options;*
 - (ii) receiving an indication of a selection of one of said plurality of selectable options associated with said displayable item;
 - (iii) receiving an input from the user identifying where the information is to be sent, *the input differing depending on the selection made in (ii);* and
 - (iv) providing an indication of said selection to said third party.

Similar limitations are included in independent claims 25 and 27.

Independent claims 21, 25 and 27 are rejected as being unpatentable over

Davis in view of Marsh.

As described above with reference to independent claim 1, neither Davis nor Marsh disclose receiving user input that differs depending on a selection of a selectable option, each option associated with a different delivery process.

Thus, neither Davis, Marsh nor any other reference cited by the Examiner teaches or suggests providing an indication of a selection of a selectable delivery option in an advertisement and user input that differs with the selected delivery option.

2. *REJECTION OF THE PRESENT INVENTION IS IMPROPER BECAUSE THERE IS NO MOTIVATION TO COMBINE THE CITED ART TO ARRIVE AT THE CLAIMED INVENTION*

The Examiner submits that “The obviousness rejection set forth would provide for plural interaction options on the banner ad, each of which corresponds to ‘learn more via telephone’ and ‘learn more via postal mail’ in addition to ‘learn more via email’ option. Clearly each of these requires different types of information in order for fulfillment.”

Applicants respectfully submit the Examiner is using impermissible hindsight, based on Applicant’s own disclosure, to combine Davis and Marsh to arrive at the presently claimed invention.

As discussed above, Marsh is directed to a system and method for scheduling displays of advertisements. The banner ads in Marsh are presented to users, and the user’s interaction with the ad banners can be tracked to gain additional information about the banner ad. The information acquired by the system in Marsh is used to schedule and target future banner ads to the user.

Davis provides a method and apparatus for tracking client interaction with a network so that targeted information can be sent to particular users based on their interests and preferences. An ad banner can then be targeted to each user based on the tracking information. By providing the user with several options the system can also be used to obtain additional user preferences.

Thus, both Davis and Marsh relate to tracking user information. In Marsh, the information is tracked to gain additional information about user preferences so that subsequent advertisements can be better targeted. Thus, in Davis and Marsh, the system is guessing the user's preferences based on their previous interactions with the system.

In contrast, the present invention specifically provides the user several choices as to additional sources of information. The user can choose to obtain the information at once, by email or by conventional delivery services. Whatever the choice, the invention is able to provide personalized responses to the user based on the user's choice in the advertisement. Thus, the website operator is able to provide the user the information that the user wants because the user selects the type of information they want to receive and how they would like to receive it by selecting an option presented in the advertisement. This can be accomplished without tracking previous interaction by the user with the system or knowing user preferences.

Thus, there is no motivation to combine the cited art to arrive at the claimed invention. In particular, there is no motivation to combine the cited art to arrive at providing information based on a selectable delivery option in an advertisement

and user input that differs with the selected delivery option or providing an indication of a selection of a selectable delivery option in an advertisement and user input that differs with the selected delivery option.

VIII. CONCLUSION

For the foregoing reasons, Appellant respectfully asserts that Claims 1-27 overcome the cited references and are therefore patentable. Those dependent claims not specifically addressed are deemed allowable in view of their dependency from an independent claim as argued above in addition to adding further limitations of their own. For the reasons presented herein, the removal of the present rejections and allowance of the present claims is respectfully requested.

Charge Our Deposit Account

If there are any further charges not accounted for herein, please charge them to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: October 4, 2006

Jennifer Hayes
Reg. No. 50,845

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(408) 720-8300

IX. APPENDIX A

The claims on appeal including the amendment mailed by the Appellant on December 12, 2005 read as follows:

1. (Previously presented) A method for providing information to a user accessing a World Wide Web site, comprising:
 - (i) serving an advertisement associated with a first World Wide Web site, wherein said advertisement has a plurality of associated selectable options that are displayed when said advertisement is displayed, further wherein each of said plurality of selectable options has an associated information delivery process, wherein the associated information delivery process differs for each of said plurality of selectable options;
 - (ii) receiving an indication of a selection of said one plurality of selectable options associated with said advertisement;
 - (iii) receiving an input from the user identifying where the information is to be sent, the input differing depending on the selection made in (ii); and
 - (iv) providing information associated with said advertisement via said information delivery process associated with the selected one of said plurality of selectable options.

2. (Original) The method of claim 1, wherein said advertisement has at least one subject matter topic associated with it and said information is directed at least in part to said subject matter topic.
3. (Original) The method of claim 1, further comprising:
 - receiving an indication of personal information used during said providing information associated with said advertisement via said information delivery process.
4. (Original) The method of claim 1, where said providing information associated with said advertisement via said information delivery process includes at least one of the following:
 - redirecting a browser to a second World Wide Web site containing said information;
 - providing a hyperlink to a second World Wide Web site, wherein said second World Wide Web site contains said information;
 - emailing said information;
 - providing an indication that said information will be provided in an email message;
 - serving said information as part of a new advertisement associated with said first World Wide Web site;
 - serving said information as part of said World Wide Web site;
 - facsimileing said information; and

mailing said information to a postal address.

5. (Original) The method of claim 1, wherein said indication of a selection of said selectable option associated with said advertisement is received from a user accessing said first World Wide Web site and further comprising:
 - determining personal information associated with said user.
6. (Original) The method of claim 5, further comprising:
 - providing at least a portion of said personal information associated with said user to a third party.
7. (Original) The method of claim 5, wherein said information delivery process is based at least in part on said personal information.
8. (Original) The method of claim 5, wherein said personal information includes at least one of the following:
 - an email address;
 - a postal address;
 - an age;
 - a telephone number;
 - a facsimile number;
 - a user preference;
 - a credit card number; and

a user identifier.

9. (Original) The method of claim 5, wherein said determining personal information associated with said user includes:

receiving an indication of said personal information associated with said user.
10. (Original) The method of claim 1, further comprising:

providing an indication of said selection of said selectable option to a third party.
11. (Original) The method of claim 1, wherein said information associated with said advertisement includes a notice that additional information will be provided by a third party.
12. (Original) The method of claim 1, wherein said information associated with said advertisement includes a request for consent to receive additional information.
13. (Original) The method of claim 11, further comprising:

receiving an indication of a consent to receive said additional information.

14. (Original) The method of claim 11, further comprising:
providing said additional information.
15. (Original) The method of claim 11, further comprising:
providing a notice that said additional information will be provided
by a third party.
16. (Original) The method of claim 11, wherein said information associated
with said advertisement includes a request for consent to receive additional
information and a notice that said additional information will be provided
by a third party.
17. (Previously presented) A method for providing information to a user
accessing a World Wide Web site, comprising:
(i) serving a displayable item associated with a World Wide Web
site, wherein said displayable item has at least two associated selectable
options and each of said two selectable options has a different associated
information delivery process;
(ii) receiving an indication of a selected one of said at least two
selectable options;
(iii) receiving an input from the user identifying where the
information is to be sent, the input differing depending on the selection
made in (ii); and

(iv) providing the information associated with said displayable item via said information delivery process associated with said selected one of said at least two selectable options.

18. (Original) The method of claim 17, wherein each of said at least two associated selectable options has a different information delivery process associated with it.
19. (Original) The method of claim 17, wherein said displayable item includes an advertisement.
20. (Original) The method of claim 17, wherein said displayable item includes at least one of the following:
 - an image;
 - a hyperlink associated with at least one of said two selectable options;
 - a banner;
 - a button; and
 - a badge.
21. (Previously presented) A method for facilitating delivery of third party information to a visitor of a World Wide Web site, comprising:

(i) displaying a displayable item on a World Wide Web site, wherein said displayable item is associated with a third party and has a plurality of associated selectable options, further wherein each of said plurality of selectable options has an associated information delivery process, wherein the associated information delivery process differs for each of said plurality of selectable options;

(ii) receiving an indication of a selection of one of said plurality of selectable options associated with said displayable item;

(iii) receiving an input from the user identifying where the information is to be sent, the input differing depending on the selection made in (ii); and

(iv) providing an indication of said selection to said third party.

22. (Original) The method of claim 21, further comprising:

providing an indication of said information delivery process to said third party.

23. (Original) The method of claim 21, further comprising:

providing contact information to said third party for use in said information delivery process.

24. (Original) The method of claim 23, wherein said contact information includes at least one of the following:

an email address;
a postal address;
a telephone number;
a facsimile number;
a user preference;
a credit card number; and
a user identifier.

25. (Previously presented) A method for facilitating information transfer to a user accessing a World Wide Web site, comprising:

(i) displaying a displayable item associated with a first World Wide Web site, wherein said displayable item has a plurality of associated selectable options, further wherein each of said plurality of selectable options has an associated information delivery process, and wherein the associated information delivery process differs for each of said plurality of selectable options;

(ii) receiving an indication of a selection of one of said plurality of selectable options associated with said displayable item;

(iii) receiving an input from the user identifying where the information is to be sent, the input differing depending on the selection made in (ii); and

(iv) providing an indication of said selection to a second World Wide Web site.

26. (Previously presented) A system for providing information, comprising:
- means for distributing an advertisement associated with a World Wide Web site, wherein said advertisement has a plurality of associated selectable options that are displayed when said advertisement is displayed, further wherein each of said plurality of selectable options has an associated information delivery process, and wherein the associated information delivery process differs for each of said plurality of selectable options;
 - means for detecting an indication of a selection of one of said plurality of selectable options associated with said advertisement;
 - means for receiving an input from the user identifying where the information is to be sent, the input differing depending on the selection made; and
 - means for transmitting information associated with said advertisement via said information delivery process associated with the selected one of said plurality of selectable options.
27. (Previously presented) An article of manufacture, comprising:
- computer program means for distributing a displayable item associated with a World Wide Web site, wherein said displayable item has at least two associated selectable options and each of said two selectable options has a different associated information delivery process;

computer program means for detecting an indication of a selected one of said at least two selectable options;

computer program means for receiving an input from the user identifying where the information is to be sent, the input differing depending on the selection made; and

computer program means for transmitting information associated with said displayable item via said information delivery process associated with said selected one of said at least two selectable options.

X. APPENDIX B: RELATED PROCEEDINGS

None

XI. APPENDIX C: EVIDENCE

None